

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Iruela-Arispe *et al.*

Appl. No. 09/373,658

Filed: August 13, 1999

For: **Meth-1 Polynucleotides (as amended)**

Art Unit: 1642

Examiner: Johnson, N.

Atty. Docket: 1488.1070006



Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated July 6, 2000, requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of Group I, represented by original claims 1-7, and claims 24-85, added in an amendment submitted herewith. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

Applicants respectfully traverse the restriction requirement as it applies to Groups I and III. It is the Examiner's positions that nucleic acids and the encoded polypeptides are patentably distinct inventions. However, even where two patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of both groups would entail a "serious burden". See MPEP § 803. In the present situation, the Examiner has clearly failed to make such a showing.

Applicants submit that a search of the polynucleotide claims would clearly provide useful information for the polypeptide claims. This is because the genetic code is known. Moreover, in many, if not most, publications, where a published nucleotide sequence is an open reading

frame, the authors also include, as a matter of routine, the deduced amino acid sequence. Thus, the searches for polynucleotides and polypeptides would clearly be overlapping.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Andrea Jo Kamage

Andrea Jo Kamage
Agent for Applicants
Registration No. 43,703

Date: November 6, 2000

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600

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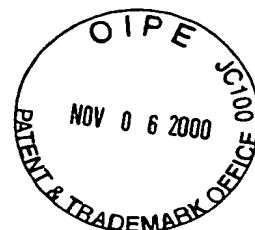
Atty. Docket: 1488.1070006

Preliminary Amendment

Commissioner for Patents
Washington, D.C. 20231

Sir:

In advance of prosecution, please amend the application as follows.



In the Inventorship

In the inventorship, please delete "Luisa Iruela-Arispe" and "Steven M. Ruben."

In the Title

Please delete the existing title and insert therefor --Meth1 Polynucleotides--.

In the Specification

At page 1, line 11, please delete " (Attorney Docket No. 1488.1070005)", and insert therein --60/147,823--.

¶ At page 102, lines 27-28, please delete "SEQ ID NO:125" and insert therein --SEQ ID NO:126, encoded by SEQ ID NO:125,--.

¶ At page 153, line 17, please delete "SEQ ID NO:125" and insert therein --SEQ ID NO:126--.